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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/868,277
Filing Date: June 15, 2001
Appellant(s): LAUTENBACHER, MARKUS

Siemens Aktiengesellschaft
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/30/2008 appealing from the Office action mailed 10/2/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|---------|-------------------|---------|
| 6757729 | Devarakonda et al | 6-2004 |
| 5365606 | Brocker et al | 11-1994 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16-20, 24-26, and 30-31 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More specifically, the added limitation of interworking programs with applications on at least one other terminal is not founded in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 16-20 and 24-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Devarakonda et al (US Patent No. 6,757,729).

As to claim 16, Devarakonda teaches In an IP-based network, a system comprising: at least one server storing application programs for implementing user specific subscribable services, said server storing said services on a per user basis; (Abstract; Fig 1; col 2, 28-40; col3, 50-56; col 4, 1-5 and 38-40)

And at least one terminal coupled to the server and having on-demand access to said IP-based network for requesting downloadable programs corresponding to said services, whereby said application programs can be executed, said downloadable programs configured to network with the application programs on at least one other terminal of the network for realizing user services. (Fig 1; col 4, 43-44; col 6, 4-8)

As to claim 17, Devarakonda teaches the system of claim 16, wherein said user specific subscribable services are supplementary to basic user services. (col 3, 50-56; col 4, 51-67; col 5, 10-24)

As to claim 18, Devarakonda teaches the system of claim 16, wherein said user specific subscribable services are supplementary to Internet Telephony service.(col 4, 11-15)

As to claim 19, Devarakonda teaches the system of claim 18, wherein said user specific subscribable services can be user configured via said at least one terminal.(Fig. 1; Fig. 4; col 3, 40-49)

As to claim 20, Devarakonda teaches the system of claim 19, wherein said server includes a Java system, and said at least one terminal supports downloading of said applications programs.(col 2, 20-23 and 49-61; col 3, 3-10; col 4, 44-47)

Claims 24 presents no new limitations above claim 16 above and is thus rejected under similar rationale.

As to claim 25, Devarakonda teaches the terminal of claim 24, wherein said application execution component is implemented as a virtual machine. (abstract)

As to claim 26, Devarakonda teaches the terminal of claim 25 wherein said user subscribable services can be configured via said client component. (col 3, lines 39-61)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being anticipated by Devarakonda et al (US Patent No. 6,757,729) further in view of Brocker et al (USPN: 5,365,606).

As to claim 30, Devarakonda teaches the system of claim 16 however, Devarakonda does not explicitly indicate that the application execution environment is being ported to the terminal only once.

Brocker et al teaches a virtual software machine that runs multiple program modules in a single address space of a target computer. Thus the application execution environment is ported only once to the terminal (col 1, lines 62 to col 2, line 13).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Brocker into those of Devarakonda to make the system to make the system more efficient. Such a system would reduce operating system resource consumption and increase transaction time (col 1, lines 56-57).

Claims 31 presents no new limitations above claim 30 above and is thus rejected under similar rationale.

(10) Response to Argument

The examiner summarizes various points made by the appellant and addresses them individually.

As per Appellant's arguments, appellant argues in substance that:

Argument A: "The specification, as originally filed, does contain support for the language added to independent claims 16 and 24" (Argument A--see brief page 5).

The examiner contends that none of the cited portions teach the limitation appearing in each independent claim directed towards "downloadable programs configured to interwork with the application programs on at least one other terminal of the network for realizing user services". Firstly, it is unclear what is meant by paragraphs 0018-0013. However, nothing in paragraphs 0013-0023 (paragraph 0023 is end of section) or 0059 support the added limitation. The specification states an

interface. "This interface has to be written only once (e.g. in C++) for each supported intelligent terminal". This is not equivalent and does not support the limitation "downloadable programs configured to *interwork* with application programs on at least one other terminal of the network for realizing user services" in any way. The specification in paragraph 0059 discloses only 1 interface not the application programs in the AXE. Furthermore, a hard to read footnote on page 5 of the brief states perhaps the most relevant portion of the specification (a portion that since has been amended/edited/removed). This portion, however, still does not disclose the above-mentioned limitation as the downloadable program does not interwork with application software. Rather, it is simply application software itself that interworks. Furthermore, the failure to adequately define the terms within the claim language adversely affects the examiner's ability to define the scope of the limitations in question (as will be evident in the response to argument B). Therefore, the examiner maintains that the rejection under 35 USC 122, 1st paragraph is still valid.

Argument B: Devarakonda's disclosed VEM is not equivalent to the AXE of the present invention because these services are provided and executed by the network (Argument B--see brief page and 9).

The examiner contends that the claims are broad, the specification is not clear, the claims are replete with intended use recitations, and that the appellants are reading limitations not in the claims, into the claims. Firstly, it is unclear as to the meaning of services to be provided or reside on a network. The claim language states that the

steps can interwork/execute/process on a terminal of the network. This is opposite of and in direct contradiction to appellant's specification (0057-0074) and arguments (see brief page 9) that states that the terminal is not a network entity. The examiner points out that this aspect of the claim language is not well disclosed, if at all, in the specification. Hence, there is a need for clarification and reinforces the validity of the aforementioned 35 USC 112, 1st paragraph rejection.

Furthermore, it should be noted that the claim language is replete with intended use recitations. The claim language contains terminology such as "configured to" and whereby clauses. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Devarakonda teaches a downloadable middleware that provides access to network services such as *local* storage. It should be noted that although the term "network" is present, the entire sentence and disclosure in general should be taken into account and not out of context.

Also, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., network/non-network entity) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Art Unit: 2157

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Asad M. Nawaz/

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/saleh najjar/

Supervisory Patent Examiner, Art Unit 2155

/Ario Etienne/

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